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10/576,478	04/20/2006	Hideki Ito	13241/15	5422
23838 7590 08/18/2009 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
NELSON, MICHAEL B				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/576,478

**Applicant(s)**

ITO ET AL.

**Examiner**

MICHAEL B. NELSON

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 04/06/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 06/04/09 has been entered. Claims 1, 2 and 3 are currently under examination on the merits. The previous 112 first paragraph rejection is withdrawn due to the fact that the changes to claim 3 in the previous amendments to the claims were made solely to rephrase already disclosed subject matter.

***Examiner's Note***

2. The use of produce-by-process limitations has been noted in new amendments, such as, for example, "made by a process comprising..." While art has been found to render these added process limitations obvious, the examiner wishes to point out that in general, even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in Thorpe, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.).

3. The examiner also notes that in claim 3 the same limitations appear to be repeated at the beginning and end of the claim (the limitations at the end of the claim containing further limitations embedded within, yet repeating some limitations none the less).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (U.S. 6,458,437), hereinafter Ito '437, in view of Ito et al. (U.S. 6,451,445), hereinafter Ito '445, and further in view of Sakamoto (U.S. 5,061,571).

Regarding claim 1, Ito '437 discloses a heat-shrinkable polyester film. Ito '437 does not disclose a second drawing step following the first drawing step, Ito '437 discloses further stretching (C5, L55-59). Ito '445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between T<sub>g</sub>-5 and T<sub>g</sub>+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

Both Ito '427 and Ito '445 are drawn to the field of heat shrinkable polyester films and therefore it would have been obvious to have used the two drawing step process of Ito '445 for the film of Ito '437 in order to improve the film's rigidity.

Modified Ito '437 does not explicitly disclose the specific instant requirements (A), (B), and (C) of the heat-shrinkable polyester film. However, in light of the substantially identical heat shrinkability in the TD and MD directions at 70°C and 85°C and the substantially identical polyester film composition (Ito '437, Table 1 and 2, C9-C10) with the instant heat shrinkability in the TD and MD directions at 70°C and 85°C

and polyester film composition (See instant specification, pages 75-83), and in view of the substantially identical drawing process, one having ordinary skill in the art would expect the film of the combination to possess the claimed properties (i.e. requirements (A), (B) and (C)), absent any objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Modified Ito '437 does not disclose that the heat-shrinkable polyester film satisfies the following requirements (D) to (E):

- (D) a three-dimensional surface roughness  $S\Delta a$  is 0.008 to 0.04;
- (E) a three-dimensional surface roughness  $SRz$  is 0.6 to 1.5 micrometers.

Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations.

(See Table 1, C3 and C4, Example 1, the lubricant is calcium carbonate present at 0.3% (calcium carbonate being a lubricant as set forth in the instant specification on page 18). The resulting surface roughness,  $Ra$ , of the film is 0.0012 and the  $Rz$  can be calculated using the  $Ra$  to  $Rz$  ratio to be 0.074 (i.e.  $0.012 \times 6.2$ ). The film has surface uniformity, excellent running property and wear resistance (See Abstract).)

The inventions of both modified Ito '437 and Sakamoto are drawn to the field of polyester films and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the surface roughness of the film of modified Ito '437 by including the inorganic particles as taught by Sakamoto for the purposes of imparting improved running property.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (U.S. 6,458,437), hereinafter Ito '437, in view of Ito et al. (U.S. 6,451,445), hereinafter Ito '445, in view of Sakamoto (U.S. 5,061,571), and further in view of Boseki (JP-2002-331581), see machine translation.

Regarding claim 2, Ito '437 discloses a heat-shrinkable polyester film. Ito '437 does not disclose a second drawing step although following the first drawing step, Ito '437 discloses further stretching (C5, L55-59). Ito '445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between Tg-5 and Tg+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

Both Ito '427 and Ito '445 are drawn to the field of heat shrinkable polyester films and therefore it would have been obvious to have used the two drawing step process of Ito '445 for the film of Ito '437 in order to improve the film's rigidity.

Modified Ito '437 does not explicitly disclose the specific instant requirements (A), (B), and (C) of the heat-shrinkable polyester film. However, in light of the substantially identical heat shrinkability in the TD and MD directions at 70°C and 85°C and the substantially identical polyester film composition (Ito '437, Table 1 and 2, C9-C10) with the instant heat shrinkability in the TD and MD directions at 70°C and 85°C and polyester film composition (See instant specification, pages 75-83), and in view of the substantially identical drawing process, one having ordinary skill in the art would

expect the film of the combination to possess the claimed properties (i.e. requirements (A), (B) and (C)), absent any objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Modified Ito '437 does not disclose that the heat-shrinkable polyester film satisfies the following requirements (F) to (G):

- (F) a light transmission at a wavelength of 380 nm is not more than 20%, and a light transmission at a wavelength of 400 nm is not more than 60%;
- (G) a Haze value is not more than 15%.

Boseki discloses a polyester film wherein:

- (F) a light transmission at a wavelength of 380 nm is not more than 20%, and a light transmission at a wavelength of 400 nm is not more than 60%;
- (G) a Haze value is not more than 15%.

(See Claim 1, hayes is assumed to be a mistranslation of haze. The disclosed numerical ranges exactly match the instant claimed ranges. The invention relates to reducing the UV light penetration of heat shrinkable polyester films for use as labels.)

The inventions of both modified Ito '437 and Boseki are drawn to the field of polyester films and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the light transmittance and haze of the film of modified Ito '437 by absorbing light in the visible light range as taught by Masuda for the purpose of reducing the UV light penetration of heat shrinkable polyester films.



Modified Ito '437 does not disclose the instant lubricant. Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations.

(See Table 1, C3 and C4, Example 1, the lubricant is calcium carbonate present at 0.3% (calcium carbonate being a lubricant as set forth in the instant specification on page 18). The resulting surface roughness, Ra, of the film is 0.0012 and the Rz can be calculated using the Ra to Rz ratio to be 0.074 (i.e.  $0.012 \times 6.2$ ). The film has surface uniformity, excellent running property and wear resistance (See Abstract).)

The inventions of both modified Ito '437 and Sakamoto are drawn to the field of polyester films and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the surface roughness of the film of modified Ito '437 by including the inorganic particles as taught by Sakamoto for the purposes of imparting improved running property.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (U.S. 6,458,437), hereinafter Ito '437, in view of Ito et al. (U.S. 6,451,445), hereinafter Ito '445, in view of Sakamoto (U.S. 5,061,571) and further in view of Hayakawa et al. (WO 02/087853), see English language equivalent (U.S. 2003/0165658).

Regarding claim 3, Ito '437 discloses a heat-shrinkable polyester film. Ito '437 does not disclose a second drawing step although following the first drawing step, Ito '437 discloses further stretching (C5, L55-59). Ito '445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between Tg-5 and Tg+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and

C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

Both Ito '427 and Ito '445 are drawn to the field of heat shrinkable polyester films and therefore it would have been obvious to have used the two drawing step process of Ito '445 for the film of Ito '437 in order to improve the film's rigidity.

Modified Ito '437 does not explicitly disclose the specific instant requirements (a), (b), and (c) of the heat-shrinkable polyester film. However, in light of the substantially identical heat shrinkability in the TD and MD directions at 70°C and 85°C and the substantially identical polyester film composition (Ito '437, Table 1 and 2, C9-C10) with the instant heat shrinkability in the TD and MD directions at 70°C and 85°C and polyester film composition (See instant specification, pages 75-83), and in view of the substantially identical drawing process, one having ordinary skill in the art would expect the film of the combination to possess the claimed properties (i.e. requirements (A), (B) and (C)), absent any objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980)).

Regarding the "heat setting" limitations at the end of claim 3, while modified Ito '437 does not explicitly disclose holding the film under tension at temperatures below the first temperature, the fact that the temperature is reduced between the first drawing step and the second drawing step implies that the film would be cooled as instantly claimed. In terms of maintaining tension, one having ordinary skill in the art would have considered it obvious to have maintained tension in the film in between the two drawing

steps in order to prevent the loss of the orientation provided in the first drawing step. Subsequently one having ordinary skill in the art would have selected a tension of the film during the transition period in between the two drawing operation in order to prevent the loss of the orientation characteristics (i.e. heat set the film).

Modified Ito '437 does not disclose that film be put on a roll having a length of 1000 to 6000 m or the instant method of obtaining samples.

Hayakawa et al. discloses a film roll of having a length of 1000 to 6000 m and wherein the samples are obtained in a following manner: an initiation end of winding of a film of steady region giving stable film properties in a longitudinal direction is defined as a first end, and a termination end of winding thereof is defined as a second end; a first cut-off point of the samples of the film is provided less than 2 m inside of the second end, and a final cut-off point is provided less than 2 m inside the first end; a plurality of sample cut-off points are provided at an interval of about 100 m from the first cut-off point.

(See [0132], the film roll is 1000m in length which falls within the instant claimed range. Also see [0187], claim 1, the location of samples on the film roll reads on the instant limitations for sample selection. The sample locations are disclosed as being chosen to ensure consistency in the film roll through out its length [0009]-[0012].)

The inventions of both modified Ito '437 and Hayakawa et al. are drawn to the field of polyester films and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the film roll length and sample locations of modified Ito '437 by using the length and sample locations of

Hayakawa et al. for the purposes of imparting increased property consistency through the film length.

Modified Ito '437 does not disclose the instant lubricant. Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations.

(See Table 1, C3 and C4, Example 1, the lubricant is calcium carbonate present at 0.3% (calcium carbonate being a lubricant as set forth in the instant specification on page 18). The resulting surface roughness, Ra, of the film is 0.0012 and the Rz can be calculated using the Ra to Rz ratio to be 0.074 (i.e.  $0.012 \times 6.2$ ). The film has surface uniformity, excellent running property and wear resistance (See Abstract).)

The inventions of both modified Ito '437 and Sakamoto are drawn to the field of polyester films and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the surface roughness of the film of modified Ito '437 by including the inorganic particles as taught by Sakamoto for the purposes of imparting improved running property.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,279,204 (Serial 10/512,412) in view of Sakamoto (U.S. 5,061,571) and Ito et al. (U.S. 6,451,445), hereinafter Ito '445.

The requirements A-C of instant claim 1 and the disclosed claim 1 are not patentably distinct. The examiner would like to reiterate that the process limitations added in the most recent claim listing do not lend patentable weight to the claims (See Examiner's Note at the beginning of the office action). As such, the double patenting rejection can be made without the last reference (Ito '445), which is used to teach the process limitations). In summation, patent number 7,279,204 in view of Sakamoto is not patentable distinct from the product limitations of claim 1 (the process limitations being moot because of the product-by-process issues). Alternatively, in view of Ito '445, even these process limitations fail to render the claims patentably distinct from the 7,279,204 patent, as explained below:

The only difference between the two sets of claims is that the disclosed upper limit of requirement (B) is not less than 70% heat shrinkage, which completely overlaps the instant claimed range of greater than 75%. For the product by process limitations, Ito

'445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between Tg-5 and Tg+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

For requirements D and E, Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations in order to impart improved surface uniformity.

12. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,279,204 (Serial 10/512,412), in view of Sakamoto (U.S. 5,061,571) in view of Boseki (JP-2002-331581), see machine translation and Ito et al. (U.S. 6,451,445), hereinafter Ito '445.

The requirements A-C of instant claim 2 and the disclosed claim 1 are not patentably distinct. The examiner would like to reiterate that the process limitations added in the most recent claim listing do not lend patentable weight to the claims (See Examiner's Note at the beginning of the office action). As such, the double patenting rejection can be made without the last reference (Ito '445), which is used to teach the process limitations). In summation, patent number 7,279,204 in view of Boseki and Sakamoto is not patentable distinct from the product limitations of claim 2 (the process limitations being moot because of the product-by-process issues). Alternatively, in view

of Ito '445, even these process limitations fail to render the claims patentably distinct from the 7,279,204 patent, as explained below:

The only difference between the two sets of claims is that the disclosed upper limit of requirement (B) is not less than 70% heat shrinkage, which completely overlaps the instant claimed range of greater than 75%. For the product by process limitations, Ito '445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between Tg-5 and Tg+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

For requirements F and G, Boseki discloses in claim 1, identical limitations on a polyester film for the purposes of reducing UV light transmission. For the lubricant requirements, Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations in order to impart improved surface uniformity.

13. Claim 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,279,204 (Serial 10/512,412), in view of Sakamoto (U.S. 5,061,571) in view of Hayakawa et al. (WO 02/087853), see English language equivalent (U.S. 2003/0165658) and Ito et al. (U.S. 6,451,445), hereinafter Ito '445.

The requirements a-c of instant claim 3, without the sample location limitations, and the disclosed requirements (A)-(C) of claim 1 are not patentably distinct. The examiner would like to reiterate that the process limitations added in the most recent claim listing do not lend patentable weight to the claims (See Examiner's Note at the beginning of the office action). As such, the double patenting rejection can be made without the last reference (Ito '445), which is used to teach the process limitations). In summation, patent number 7,279,204 in view of Hayakawa et al. and Sakamoto is not patentable distinct from the product limitations of claim 3 (the process limitations being moot because of the product-by-process issues). Alternatively, in view of Ito '445, even these process limitations fail to render the claims patentably distinct from the 7,279,204 patent, as explained below:

The only difference between the two sets of claims is that the disclosed upper limit of requirement (B) is not less than 70% heat shrinkage, which completely overlaps the instant claimed range of greater than 75%. For the product by process limitations, Ito '445 discloses a process for drawing a heat shrinkable polyester film in which an initial drawing step is taken at between Tg-5 and Tg+15 with a drawing factor of 4.5 or more in the shrinkage direction (C5, L5-12 and C5, L30-35) followed by a second drawing process at about 5 degrees Celsius lower than the first step (i.e. 65-85 degrees Celsius for the second step vs. 70-90 degrees for the first step, C5, L1-20) with a draw ratio of 1.05 or more. The purpose of the second drawing step is to improve the film's rigidity (C5, L15-20).

For the film role sample location limitations, Hayakawa et al. discloses the same limitations in claim 1. The film role length would have been considered a result effective



variable by those having ordinary skill at the time of the invention. For the lubricant requirements, Sakamoto discloses a polyester film meeting the instant surface roughness and lubricant limitations in order to impart improved surface uniformity.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

/MN/  
06/11/09